

REMARKS

The Office Action dated September 21, 2004, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

Claims 15-16 have been amended. Applicants submit that the amendments made herein are fully supported in the specification and the drawings as originally filed, and therefore no new matter has been added. Accordingly, claims 1-19 are pending in the present application, and claims 15 and 16 are respectfully submitted for consideration.

Allowed Claims and Allowable Subject Matter

As a preliminary matter, Applicants appreciate the indication of allowable subject matter in claims 17-19 of the present application. Applicants also appreciate the allowance of claims 1-14.

Claims 15 and 16 Recite Patentable Subject Matter

Claims 15-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kishi et al. (U.S. Patent No. 5,987,635, "Kishi"). Applicants respectfully traverse the rejection and submit that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Claim 15 recites a semiconductor integrated circuit comprising, among other features, a test control circuit being operative in a test mode which tests the semiconductor integrated circuit, for inhibiting output of said control signals.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicants' invention.

The Office Action characterized Figure 4 of Kishi as allegedly disclosing "memory device comprising ... a test control circuit (16, 17, 18) being operative in a test mode (when signal at 32 is applied at 18) for inhibiting output of the control signals." In particular, the Examiner highlighted column 8, lines 1-20 and further characterized Kishi that "the terminal TM would be considered as a test starting terminal because this terminal receives a test starting signal."

Applicants submit that Kishi fails to disclose or suggest each and every element recited in claim 15 of the present application. In particular, it is submitted that elements 16, 17 and 18 of Kishi are neither comparable nor analogous to the test control circuit of the present invention as recited in claim 15. In fact, elements 16, 17 and 18 of Kishi fails to operate in a test mode which tests the semiconductor integrated circuit, for inhibiting output of said control signals. Moreover, the image processor 11 and the memory circuit unit 20A (memory core 22) of Kishi both follow the same manufacturing process, whereas the features recited in the present invention do not. In Kishi this is due to the circuit unit being formed on the silicon substrate 60 (col. 7, lines 43-44).

Furthermore and in contrast to the present invention, Kishi does not disclose a test starting signal (or a test starting terminal) to test a semiconductor integrated circuit. Therefore, Applicants submit that Kishi fails to disclose each and every element recited in claim 15 of the present application.

Moreover, to qualify as prior art under 35 U.S.C. §102, a single prior art reference must teach, i.e., identically describe, each feature of a rejected claim. As explained above, Kishi fails to disclose or suggest each and every feature of claim 15. Accordingly, Applicants respectfully submit that claim 15 is not anticipated by nor rendered obvious by the disclosure of Kishi. Therefore, Applicants respectfully submit that claim 15 is allowable.

As claims 16 depends from claim 15, Applicants submit that claim 16 incorporates the patentable aspects therein, and is therefore allowable for at least the reasons set forth above with respect to the independent claim, as well as for the additional subject matter recited therein.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Conclusion

In view of the above, Applicants respectfully submit that each of claims 15 and 16 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicants also submit that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 15 and 16 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. 108397-00105.

Respectfully submitted,



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